

REMARKS

Based on the manifest differences between the cited references and the pending claims, the Applicant believes that the following remarks will convince the Examiner that the rejections in the June 29, 2006 Office Action and in the July 6, 2007 Advisory Action should be reconsidered and withdrawn.

A. Claim Rejections Under 35 U.S.C. § 102(e)

The Examiner rejected claims 41, 44, 46, 47, 50, 53-55, 57, 61, and 64 under 35 U.S.C. §102(e) as being anticipated by Purcell U.S. Patent Number 6,081,789 (“Purcell”). Applicant respectfully disagrees.

Claim 41 requires, *inter alia*, the step of “establishing information and business rules common to members of each of one or more transaction communities stored in a database”. Applicant respectfully submits that Purcell does not disclose at least this step.

The examiner has indicated in his June 29, 2006 Office Action (and reiterated the rejection basis in his July 6, 2007 Advisory Action) that this element is disclosed at column 9 of Purcell. The examiner quotes from column 9, lines 16-18, “As previously described, the host and manager of this system will want only those entities that are approved subscribers (meet requirements of a set of rules) to have access.” (Parenthetical phrase added by Examiner and are not part of the Purcell reference). (June 29, 2006 Office Action, p 3). The Purcell reference continues only to say that “an initial step of both sellers and buyers is to solicit authorization for admission into the system from the host administrator or access approvers 12, 15.” (col. 9, ll. 19-21). Despite the

Examiner's parenthetical interjection, nowhere does the Purcell reference disclose "establishing information and business rules common to members of each of one or more transaction communities stored in a database".

At best the Examiner is indicating that it is inherent that, by soliciting authorization for admission into the system, and being granted access, users "meet requirements of a set of rules". Applicant respectfully submits that this argument for finding disclosure of "establishing information and business rules common to members of each of one or more transaction communities stored in a database" fails as well.

The MANUAL OF PATENT EXAMINING PROCEDURE ("MPEP") requires that the Examiner provide rationale or evidence tending to show inherency. MPEP § 2112 IV. The Examiner has not met his burden to "provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

Furthermore, the Examiner has not shown the inherency of "establishing information and business rules common to members" through the approval of users because the Examiner cannot show that the simple act of approving users that solicited approval necessitates "establishing information and business rules common to members". A host could use any number of bases for approval of a user well short of "establishing information and business rules common to members".

There is simply no disclosure in the Purcell reference or rationale in the Examiner's rejection to indicate that through the approval process, Purcell discloses

“establishing information and business rules common to members of each of one or more transaction communities stored in a database” as required by claim 41.

Further, claim 41 requires, *inter alia*, that “said transaction community comprises an account pool and associated electronic communication interfaces for said creditor and said user to conduct said interactive exchange of said information”. Applicant respectfully submits that the Purcell reference does not disclose at least this step.

The examiner has indicated in his June 29, 2006 Office Action (and maintained the rejection basis in his July 6, 2007 Advisory Action) that this element is disclosed at column 9 of Purcell. The examiner quotes from column 9, lines 25-28, “After a buyer or seller is approved for access, they will be issued an identifier (this represents an account, all of the identifiers constitute a pool) such as an identification number or name for use when seeking access to the management system through the website.” (Parenthetical phrase added by Examiner and are not part of the Purcell reference). (June 29, 2006 Office Action, p 3). Despite the Examiner’s parenthetical interjection, the Examiner has not shown a disclosure of a “transaction community comprises an account pool”.

Nothing the Examiner cited in Purcell, nor anywhere else in the Purcell reference is it disclosed that the identifiers are grouped into account pools, let alone that the identifiers make up a “transaction community [that] comprises an account pool”. The Purcell reference continues only to say that, “[a]s a further security measure and as is common to many access-upon-request systems, a complimentary password will also be issued that doubly insures that those parties accessing the information exchange system have been previously authorized by the host.” (col. 9, ll. 28-32). Here, the Purcell reference is indicating that the Purcell identifier serves simply as a log-on ID to “insure[] that those

parties accessing the information exchange system have been previously authorized by the host” (col. 9, ll. 28-32) and not, as argued by the Examiner, as a means to “comprise[] an account pool”.

At best the Examiner is indicating that it is inherent that, by issuing identifiers to authorized users, the issued identifiers comprise a pool. Applicant respectfully submits that this argument for finding disclosure of “said transaction community comprises an account pool” fails as well.

The MPEP requires that the Examiner provide rationale or evidence tending to show inherency. MPEP § 2112 IV. The Examiner has not met his burden to “provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

Furthermore, the Examiner has not shown the inherency of “said transaction community compris[ing] an account pool” through the issuance of identifiers to authorized users because the Examiner cannot show that the simple act of issuing an identifier to an authorized user necessitates that all of the identifiers must constitute a pool. Identifiers could be issued to authorized users for any number of reasons well short of necessarily lumping the identifiers into an account pool.

In fact, the Purcell reference gives other reasons for issuing identifiers that are completely inapposite to the claim 41 requirement that a “transaction community comprises an account pool”. For example:

Each seller and each buyer is issued a unique identifier utilized by the host information management system to identify each upon their log in into the

host information management system. This log in identifier, such as a company identification number and/or password will be recognized and recorded by the host information management system for usage tracking, billing, and other purposes.

(col. 4, ll. 45-51).

There is simply no disclosure in the Purcell reference or rationale in the Examiner's rejection to indicate that the Purcell reference discloses through the issuance of identifiers "said transaction community comprises an account pool and associated electronic communication interfaces for said creditor and said user to conduct said interactive exchange of said information" as required by claim 41.

The applicant therefore respectfully submits that Purcell fails to disclose all of the limitations of claim 41, and requests that this rejection be reconsidered and withdrawn. Claims 44, 46, 47, 50 and 53 were also rejected as anticipated by Purcell and each depend from allowable claim 41. Applicant respectfully requests that these rejections also be reconsidered and withdrawn.

Further, claim 54 requires, *inter alia*, that "said transaction community comprises an account pool and associated electronic communication interfaces for said creditor and said user to conduct said interactive exchange of said information". Applicant respectfully submits that the Purcell reference does not disclose at least this step.

The examiner has indicated in his June 29, 2006 Office Action (and maintained the rejection basis in his July 6, 2007 Advisory Action) that this element is disclosed at column 9 of Purcell. The examiner quotes from column 9, lines 25-28, "After a buyer or seller is approved for access, they will be issued an identifier (this represents an account, all of the identifiers constitute a pool) such as an identification number or name for use when seeking access to the management system through the website." (Parenthetical

phrase added by Examiner and are not part of the Purcell reference). (June 29, 2006 Office Action, p 3). Despite the Examiner's parenthetical interjection, Purcell is not a disclosure that a "transaction community comprises an account pool". Nothing the Examiner cited in Purcell, nor anywhere else in the Purcell reference is it disclosed that the identifiers are grouped into account pools, let alone that the identifiers make up a "transaction community [that] comprises an account pool". The Purcell reference continues only to say that, "[a]s a further security measure and as is common to many access-upon-request systems, a complimentary password will also be issued that doubly insures that those parties accessing the information exchange system have been previously authorized by the host." (col. 9, ll. 28-32). Here, the Purcell reference is indicating that the Purcell identifier serves simply as a log-on ID to "insure[] that those parties accessing the information exchange system have been previously authorized by the host" (col. 9, ll. 28-32) and not, as argued by the Examiner, as a means to "comprise[] an account pool".

At best the Examiner is indicating that it is inherent that, by issuing identifiers to authorized users, the issued identifiers comprise a pool. Applicant respectfully submits that this argument for finding disclosure of "said transaction community comprises an account pool" fails as well.

The MPEP requires that the Examiner provide rationale or evidence tending to show inherency. MPEP § 2112 IV. The Examiner has not met his burden to "provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior

art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

Furthermore, the Examiner has not shown the inherency of “said transaction community compris[ing] an account pool” through the issuance of identifiers to authorized users because the Examiner cannot show that the simple act of issuing an identifier to an authorized user necessitates that all of the identifiers must constitute a pool. Identifiers could be issued to authorized users for any number of reasons well short of necessarily lumping the identifiers into an account pool.

In fact, the Purcell reference gives other reasons for issuing identifiers that are completely inapposite to the claim 54 requirement that a “transaction community comprises an account pool”. For example:

Each seller and each buyer is issued a unique identifier utilized by the host information management system to identify each upon their log in into the host information management system. This log in identifier, such as a company identification number and/or password will be recognized and recorded by the host information management system for usage tracking, billing, and other purposes.

(col. 4, ll. 45-51).

There is simply no disclosure in the Purcell reference or rationale in the Examiner’s rejection to indicate that the Purcell reference discloses through the issuance of identifiers “said transaction community comprises an account pool and associated electronic communication interfaces for said creditor and said user to conduct said interactive exchange of said information” s required by claim 54.

The applicant therefore respectfully submits that Purcell fails to disclose all of the limitations of claim 54, and requests that this rejection be reconsidered and withdrawn. Claims 55, 57, 61 and 64 were also rejected as anticipated by Purcell and each depend

from allowable claim 41 and simply add further limitations. Applicant respectfully requests that these rejections also be reconsidered and withdrawn.

B. Claim Rejections Under 35 U.S.C. § 103(a)

The Examiner has also maintained his rejection of claims 42, 43, 45, 48, 49, 51, 52, 56, 58-60, 62 and 63 under 35 U.S.C. 103(a) as being unpatentable over Purcell in view of United States Patent No. 5,970,475 to Barnes, *et al.* ("Barnes").

For each of these rejected claims, the Examiner argued only that:

Barnes teaches an electronic procurement system and method for trading partners. An Electronic Commerce system enables corporate purchasers and suppliers to electronically transact for the purchase and supply of goods/services. The system includes three major hardware and software components: buyer, supplier and bank/administrator. This system facilitates commerce.

Based on the teaching of Barnes *et al.*, it would have been obvious, at the time of the invention to modify the Purcell system to incorporate a financial exchange system like the Barnes invention, including ordinary matters of business, within the access pool of the Purcell inventory information exchange in order to facilitate commerce.

(June 29, 2006 Office Action, p 4).

§ 2143 of the MPEP describes the basic requirements of a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(§ 2143 of the MPEP)

Applicant respectfully submits that the Examiner has not made a *prima facie* case of obviousness with regard to claim 42. Claim 42 requires “wherein said user may provide information selected from the group consisting of an account number, and account specific information.”

First, the teaching, suggestion, or motivation must be found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *See*, MPEP § 2143.01. The Examiner’s simple statement that the Barnes system “facilitate commence” simply does not meet this burden. Further, the Examiner’s argument provides Applicant no opportunity to argue or address whether there is a teaching, suggestion, motivation or reason to combine.

To establish *prima facie* obviousness of a claimed invention, also requires that all the claim limitations be taught or suggested by the prior art. *See*, MPEP § 2143.03, *See also, In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The Examiner has not indicated where Barnes teaches or suggests the limitation of claim 42, or whether the specific limitation of claim 42 could be found at all in the references.

Further, while obviousness does not require absolute predictability, at least some degree of predictability is required. *See*, MPEP § 2143.02. With regard to this claim, the Examiner has not indicated any reasonable expectation of success for any necessary modification or combination of references.

Finally, in the July 6, 2007 Advisory Action, the Examiner argues that the obviousness rejections are proper in lights of the recent *KSR Int’l Co. v. Teleflex, Inc.* Supreme Court decision. Applicant suggests that the requirements for a *prima facie* case

of obviousness as defined in the MPEP still control. Further, we direct the Examiner to the May 3, 2007 Memorandum regarding the “Supreme Court decision on *KSR Int’l Co. v. Teleflex, Inc.*” from Margaret A. Focarino, Deputy Commissioner for Patent Operations to the Technology Center Directors. Ms. Focarino, citing heavily from the *KSR Int’l Co. v. Teleflex, Inc.* decision, makes clear an Examiners obligation in finding a claim obvious.

Therefore, in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.

(May 3, 2007 Memorandum regarding the “Supreme Court decision on *KSR Int’l Co. v. Teleflex, Inc.*” from Margaret A. Focarino, Deputy Commissioner for Patent Operations to the Technology Center Directors, p.2). **(Emphasis in original).**

For the same reasons provided that Applicant argues that the Examiner has failed to make a *prima facie* case of obviousness, Applicant respectfully submits that the Examiner’s argument regarding the Barnes reference has also failed “to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.”

Accordingly, Applicant respectfully submits that the rejection of claim 42 is traversed.

Applicant respectfully submits that the Examiner has not made a *prima facie* case of obviousness with regard to claim 43. Claim 43 requires “wherein said interactive exchange includes authorizing a payment transaction with said creditor that can be processed, funded and reported by the system through use of account specific information

provided by said user.” For the same reasons argued above with regard to claim 42, Applicant respectfully submits that the rejection of claim 43 is traversed.

Applicant respectfully submits that the Examiner has not made a *prima facie* case of obviousness with regard to claim 45. Claim 45 requires “consolidating payments received from said users such that collected payments are properly allocated to said creditors.” For the same reasons argued above with regard to claim 42, Applicant respectfully submits that the rejection of claim 45 is traversed.

Applicant respectfully submits that the Examiner has not made a *prima facie* case of obviousness with regard to claim 48. Claim 48 requires “allowing said user to resolve said bill or debt using their checking account.” For the same reasons argued above with regard to claim 42, Applicant respectfully submits that the rejection of claim 48 is traversed.

Applicant respectfully submits that the Examiner has not made a *prima facie* case of obviousness with regard to claim 49. Claim 49 requires “verifying the availability of funds in said checking account prior to resolving said debt or said bill.” For the same reasons argued above with regard to claim 42, Applicant respectfully submits that the rejection of claim 49 is traversed.

Applicant respectfully submits that the Examiner has not made a *prima facie* case of obviousness with regard to claim 51. Claim 51 requires “providing at least one of a plurality of reports accessible by said user or said creditor, said reports providing transaction information from all payment channels.” For the same reasons argued above with regard to claim 42, Applicant respectfully submits that the rejection of claim 51 is traversed.

Applicant respectfully submits that the Examiner has not made a *prima facie* case of obviousness with regard to claim 52. Claim 52 requires “wherein said information and business rules are selected from the group consisting of coordination of service termination status accounts, minimum payment requirements, payment method limitations, and payment method privilege suspension.” For the same reasons argued above with regard to claim 42, Applicant respectfully submits that the rejection of claim 52 is traversed.

Applicant respectfully submits that the Examiner has not made a *prima facie* case of obviousness with regard to claim 56. Claim 56 requires “allocating consolidated payment funds to said creditors.” For the same reasons argued above with regard to claim 42, Applicant respectfully submits that the rejection of claim 56 is traversed.

Applicant respectfully submits that the Examiner has not made a *prima facie* case of obviousness with regard to claim 58. Claim 58 requires “allowing said user to access information unrelated to said bill or said debt, said unrelated information including financial, employment or demographic information.” For the same reasons argued above with regard to claim 42, Applicant respectfully submits that the rejection of claim 58 is traversed.

Applicant respectfully submits that the Examiner has not made a *prima facie* case of obviousness with regard to claim 59. Claim 59 requires “allowing said user to resolve said bill or debt using their checking account.” For the same reasons argued above with regard to claim 42, Applicant respectfully submits that the rejection of claim 59 is traversed.

Applicant respectfully submits that the Examiner has not made a *prima facie* case of obviousness with regard to claim 60. Claim 60 requires “verifying the availability of funds in said checking account prior to resolving said debt or said bill.” For the same reasons argued above with regard to claim 42, Applicant respectfully submits that the rejection of claim 60 is traversed.

Applicant respectfully submits that the Examiner has not made a *prima facie* case of obviousness with regard to claim 62. Claim 62 requires “providing at least one of a plurality of reports accessible by said user or said creditor, said reports providing transaction information from all payment channels.” For the same reasons argued above with regard to claim 42, Applicant respectfully submits that the rejection of claim 62 is traversed.

Applicant respectfully submits that the Examiner has not made a *prima facie* case of obviousness with regard to claim 63. Claim 63 requires “wherein said information and business rules are selected from the group consisting of coordination of service termination status accounts, minimum payment requirements, payment method limitations, and payment method privilege suspension.” For the same reasons argued above with regard to claim 42, Applicant respectfully submits that the rejection of claim 63 is traversed.

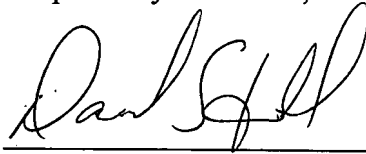
CONCLUSION

In view of the foregoing, Applicant respectfully submits that the present application as claimed in claims 41-64 represents a patentable contribution to the art and

the application is in condition for allowance. Early and favorable action is accordingly solicited.

Dated: August 3, 2006

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "David M. Hill", written over a horizontal line.

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